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Ser. No. 09/809,488

**REMARKS**

Claims 9-20 remain in this application. Claims 9-20 are rejected. Claims 9, 12 and 13 are amended herein to clarify the invention and to address matters of form unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objection cited in the above-referenced Office Action.

Claims 13-20 are rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter lacking an adequate written description in the specification. Applicants herein respectfully traverse this rejection.

The description requirement of the first paragraph of 35 U.S.C. § 112 functions to ensure that the inventor had possession of the subject matter later claimed. How the specification satisfies this requirement is immaterial. It is not necessary that the application describe every claim exactly, but only so much that persons of ordinary skill in the art will recognize from the disclosure that the applicant invented the subject matter with the claimed limitations. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90, 96 (CCPA 1976). A determination of fulfillment of the description requirement under § 112, first paragraph, turns on whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986).

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Independent claim 13 describes in very simple and straightforward terms the steps practiced in accordance with the disclosed invention, and the claimed subject matter thereof finds full antecedent support in the disclosure (see page 10, line 25-page 11, line 5; page 13, line 24-page 14, line 1). However, in consideration of the Examiner's stated position that the order of the method of mounting does not match what has been disclosed, in that mounting comes before the measurement in the claim, claim 13 is amended to change the order of the steps, such that the "further moving" and "mounting" steps are placed at the end of the claim, and these steps more appropriately refer to the subsequently fed and picked-up component, a component feeding position of which has been corrected in accordance with the preceding steps, particularly since the claim is directed to a method of mounting a component which provides improved placement accuracy for the subsequently mounted component. Regarding the dependent claims, it is respectfully submitted that clear support is found also in the disclosure. For example, claim 15 finds support at page 14, lines 12-17 and claims 16-18 in the paragraph bridging pages 14 and 15.

Therefore, in view of the above, reconsideration of the rejections of claims 13-20 is respectfully requested. Should such rejections be maintained, it is requested that the Examiner explain the grounds for the rejections, addressing the above remarks, to comply with satisfying the burden of the PTO in asserting the rejection. "The burden of showing that the claimed invention is *not* described in the application

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rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient." *In re Edwards, Rice, and Soulen*, 196 U.S.P.Q. 465, 469 (CCPA 1978) citing: *In re Salem*, 553 F.2d 676, 682, 193 USPQ 513, 518 (CCPA 1977); *In re Wertheim*, 541 F.2d at 265, 191 USPQ at 98.

Claims 9-20 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of informalities stated in the Office Action. The claims are amended to remove or correct the informalities noted in the Office Action. In particular, claims 9 and 12 are amended to correct the lacking antecedent bases. With regard to claims 13 and 15-18, the issues referred to with regard to the instant rejections have been addressed above as they pertain to the 35 U.S.C. § 112, first paragraph rejections. Therefore, reconsideration of the rejection of claims 9-20 and their allowance are earnestly requested.

The Office Action states that claims 9-12 contain allowable subject matter and would be allowed if amended to overcome their rejection under 35 U.S.C. § 112, second paragraph. The claims are submitted as so amended, and as noted above herein. Accordingly, claims 9-12 are believed to be in condition for allowance.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,  
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